

wire for alerting the presence of conduit located beneath the ground after back-filling the trench.

Claim 18. The insulating wire separator apparatus of claim [17] 23, wherein the main conduit  
5 receiving portion comprises a first half radiused portion, with a second half radiused portion  
releasably secured to said first half radiused portion with a suitable releasable fastening means.

Claim 19. The insulating wire separator apparatus of claim [10] 23, wherein the tracer wire  
10 clip finger portion is angled from three to thirty degrees from the centerline of said arm  
portion, to engage varying sizes of tracer wire therein.

Claim 20. The insulating wire separator apparatus of claim [10] 23, wherein the insulating  
wire separator apparatus is color coded, with a separate color used for each utility.

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#### REMARKS

There were three independent claims and a total of 20 claims in the application as filed.

There are now three independent claims and a total of 20 claims in the application as  
amended. Therefore, no additional claim fee is believed to be required.

20 The specification has been amended to incorporate the recommended headings in the  
specification, and priority of the provisional patent application is included on page 1 of the

specification.

The specification has been amended in accordance with the Examiner's recommendations. The claim objections have also been amended in accordance with the Examiner's recommendations.

5           Figure 1 and Figure 7A have been amended in the Drawings, in accordance with the Examiner's recommendations.

The 35 USC 112 rejections have been addressed and corrected, in accordance with the Examiner's recommendations.

          Claims 1-3 and 5-8 are rejected under 35 USC 103(a) as being anticipated by U.S. Patent 5,601,260 issuing to Shinohara et al. 5,601,260 differs substantially from applicant's invention. 5,601,260 discloses and claims securing the retainer in a mounting hole extending through a mounting plate. See independent claims 1, 11 and 17. This teaches away from applicant's invention, as applicant's invention engages a main conduit at one end, and a tracer wire clip portion at the opposite end. 5,601,260 will not work to separate a tracer wire from a  
10           main conduit as taught by applicant's invention. The insulating wire separator apparatus is buried with the main conduit to position a tracer wire a safe distance from the main conduit to protect the conduit from becoming damaged or melted from an accidental electrical charge or by a lightning strike, and so that the location of the main conduit may be identified to avoid damage to the main conduit, when future digging occurs. One of average skill in this art  
15           would not look to 5,601,260 to find a solution to locating and protecting buried conduit in a back-filled trench.  
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Numerous other differences in structure between applicant's invention and 5,601,260 include the use of transverse groove portions 14 formed on both surfaces of the proximal end portion of the frame 12 to aid in gripping. (Column 4, lines 44-51). The use of engaging portions 32 and paul pieces 34 at one end to secure the retainer in a mounting hole extending through a mounting plate(Figure 6); the use of a V-shaped guide portion to guide degaussing coils 42 into the retaining space 44 (Column 6, lines 3-6 and Figure 2); the use of a thick plate section 20 at a distal end side of the frame 12 (Column 4, lines 53-56); the use of a groove 22 cut in the form of an arc (Column 4, lines 56--59); and the use of arc shaped clamp plates 41 plates and elongated stay plates 48 (Column 5, lines 60-65).

Thus, claim 1, rewritten as new claim 21 is believed to be allowable over the cited prior art. For the reasons cited herein, and further because claims 2-3 and 5-8 are dependent claims, and serve to teach applicant's preferred invention, these claims are also believed allowable. The dimensions cited in applicant's claims are not merely a matter of design choice, as they are critical to the intended function of the invention. There is no teaching in the cited prior art of the advantages of these dimensional limitations, which provide advantages now specified in the claims. In claim 5, the color coding is used to identify separate utility conduit, which has significant advantages not taught in the cited prior art. In claims 7 and 8, the opening is sized to enable the insulating wire separator apparatus to resiliently engage the conduit without requiring tools. This advantage is especially useful in a trench where space is at a premium. Thus allowance of claims 2-3 and 5-8 is earnestly sought.

The examiner has rejected claim 9 under 35 USC 103(a) in view of Shinohara to

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Respectfully submitted,  
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Enclosure: Clean Copy of Application & Claims

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